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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,993	04/10/2006	Keiichi Yamamoto	ES/4676-916	1366

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ARLINGTON, VA 22203

EXAMINER
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PAUL, JESSICA MARIE

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,993	<b>Applicant(s)</b> YAMAMOTO ET AL.	
	<b>Examiner</b> Jessica Paul	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

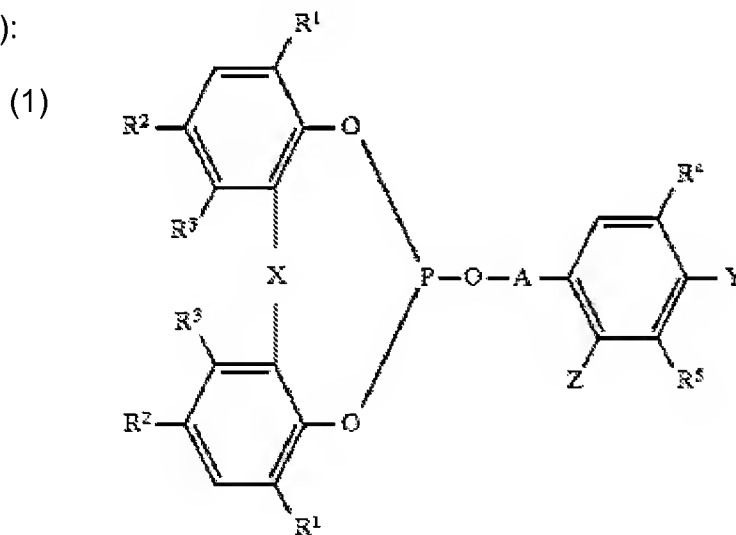
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Inue et al. (US Patent No. 5889095).

Inue et al. discloses a phosphite stabilizer for organic material represented by the following formula (1):



Wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>4</sup>, and R<sup>5</sup> can be an alkyl; R<sup>3</sup> is hydrogen; X is a direct bond; A is an alkylene group having 2 to 8 carbon atoms; and one of Y and Z represent a hydroxyl (col1,line65-col2, line33).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

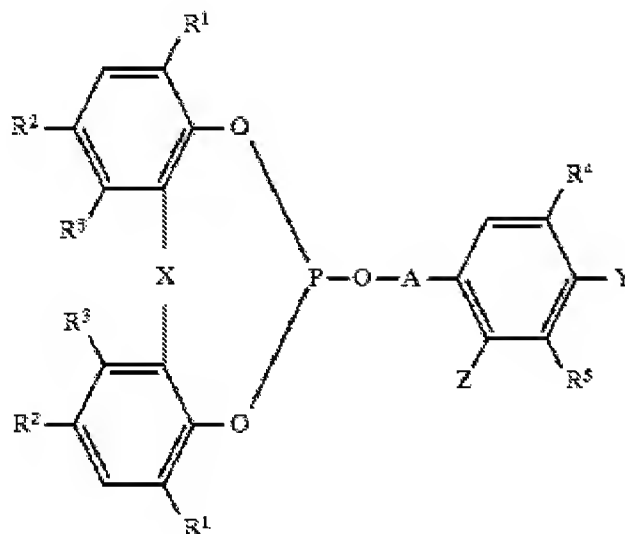
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 8, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shustack (U.S. Patent No. 5146531) and further in view of Inue et al. (US Patent No. 5889095).

Regarding claims 3-6 and 11; Shustack teaches an ultraviolet radiation-curable primary and secondary coating composition for optical fibers (abs), wherein the primary coating composition comprises: (A) 20-80% by weight of the total composition of a urethane acrylate system [urethane (meth)acrylate (B)] (col7, line1), (B) 5-50% by weight of the total composition of an alkyl acrylate or (meth)acrylate-based monomer [reactive diluent (C)] (col9, line8), and optionally (C) 0.1-3% by weight of the total composition of a stabilizer such as organic phosphites, hindered phenols, mixtures thereof, and the like [compound (A), formula (1)] (col12,line42). However, Shustack fails to teach the specified organic phosphite stabilizer as required by instant formula (1).

Inue et al. discloses a phosphite stabilizer for organic material represented by the following formula (1):

(1)



Wherein  $R^1$ ,  $R^2$ ,  $R^4$ , and  $R^5$  can be an alkyl;  $R^3$  is hydrogen; X is a direct bond; A is an alkylene group having 2 to 8 carbon atoms; and one of Y and Z represent a hydroxyl [col1,line65-col2, line33). Shustack and Inue et al. are combinable because they are both concerned with the same field of endeavor, namely organic materials and/or compositions, such as thermoplastic resins, which contain phosphite stabilizers. At the time of the invention, a person having ordinary skill in the art would have found it obvious to use the organic phosphite stabilizer of formula (1), as disclosed by Inue et al., in the radiation curable coating composition as taught by Shustack, and would have been motivated to do so in order to produce a coating composition having excellent stability to heat deterioration and oxidation deterioration in production, processing, and use (Inue et al., col22, line9-14).

Regarding claims 8 and 9, Shustack discloses a process for preparing a coated optical fiber, wherein the process comprises: (i) applying to an optical glass fiber a primary coating layer, (ii) applying atop said primary coating layer a secondary coating

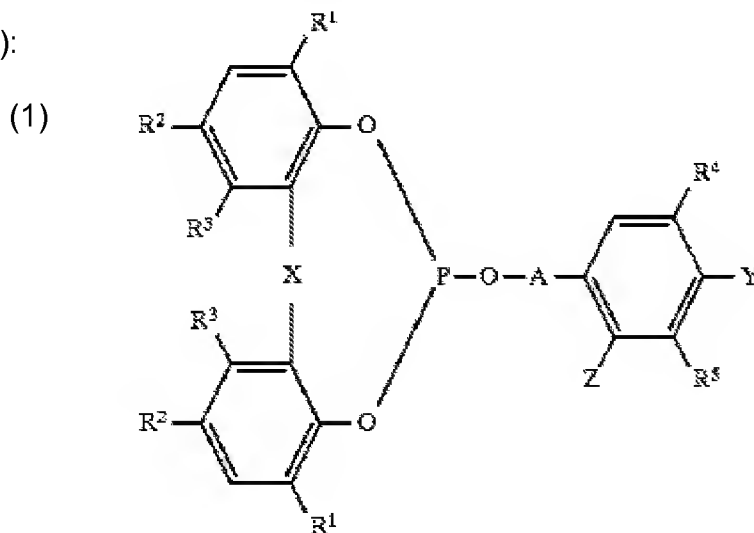
layer, and (iii) radiation-curing in situ said primary and secondary coating layers (col16, line1).

Regarding claim 12; Shustack discloses a secondary coating (col13, line26-col14, line60) which may contain various stabilizers, including but not limited to one or more or organic phosphites, hindered phenols, mixtures thereof, and the like (col15, line20-24).

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop et al. (U.S. Patent No. 6714712) and further in view of Inue et al. (US Patent No. 5889095).

Bishop et al. disclose a radiation-curable coating, ink or matrix composition comprising: (A) a polyester (meth)acrylate oligomer; (B) a reactive diluent; and (C) a photoinitiator (col5, line36-42). The composition may further comprise stabilizers, in particular color stabilizers, such as trisnonyl phenol phosphite, trisphenol phosphite, and the like. However, Bishop et al. fails to teach the specified organic phosphite stabilizer as required by instant formula (1).

Inue et al. discloses a phosphite stabilizer for organic material represented by the following formula (1):



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Wherein  $R^1$ ,  $R^2$ ,  $R^4$ , and  $R^5$  can be an alkyl;  $R^3$  is hydrogen; X is a direct bond; A is an alkylene group having 2 to 8 carbon atoms; and one of Y and Z represent a hydroxyl [col1,line65-col2, line33). Bishop et al. and Inue et al. are combinable because they are both concerned with the same field of endeavor, namely organic materials and/or compositions, such as thermoplastic resins, which contain phosphite stabilizers. At the time of the invention, a person having ordinary skill in the art would have found it obvious to use the organic phosphite stabilizer of formula (1), as disclosed by Inue et al., in the radiation curable ink or matrix composition as taught by Bishop et al., and would have been motivated to do so in order to produce a composition having excellent stability to heat deterioration and oxidation deterioration in production, processing, and use (Inue et al., col22, line9-14).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Paul whose telephone number is (571)270-5453. The examiner can normally be reached on Monday thru Friday 8:00- 6:00p; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/  
Supervisory Patent Examiner, Art Unit 1796

Jessica Paul  
Examiner  
Art Unit 1796

/JMP/